

## REMARKS

In the June 1, 2005, first Office Action in this application, the United States Patent and Trademark Office (hereinafter "the Office") rejected Claims 1, 2, 4-8, 15-19, 21-23, 26-28, 32, and 34 under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of U.S. Patent No. 5,774,170, issued to Hite et al. (hereinafter "Hite et al."), and further in view of the teachings of U.S. Patent No. 6,061,719, issued to Bendinelli et al. (hereinafter "Bendinelli et al."). Claims 29-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Hite et al., Bendinelli et al., and further in view of the teachings of U.S. Patent Application No. 2001/0025377, filed by Hinderks (hereinafter "Hinderks"). Claims 9-14, 20, 24, 25, and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Hite et al., Bendinelli et al., and Hinderks. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Hite et al., Bendinelli et al., and further in view of the teachings of U.S. Patent No. 6,177,931, issued to Alexander et al. (hereinafter "Alexander et al."). The Office did not indicate that the drawings were acceptable and such an indication is respectfully requested in the next communication. Without admitting to the propriety of the rejections of the Office, applicant has amended Claims 1, 7, 10, 14, 15, 18, 19, 22, 26, 27, 29, and 30-34 to clarify the subject matter of the claimed invention.

Prior to discussing in detail why applicant believes that all of the claims in this application are allowable, a brief description of the applicant's invention and a brief description of the teachings of the cited and applied references are provided. The following background and the discussions of the disclosed embodiments of applicant's invention and the teachings of the applied and cited references are not provided to define the scope or interpretation of any of the claims of this application. Instead, such discussions are provided to help the Office to better appreciate important claim distinctions discussed thereafter.

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### Summary of the Claimed Invention

Applicant's claimed invention is directed to a method, an article of manufacture, an apparatus, and an interactive television system. As an example, a method form of the invention includes a method that comprises sending one or more television signals to a client terminal via a first channel of a communication network. Prior to being sent to the client terminal, the television signal includes information related to a first advertisement present in the television signal. The method further comprises aggregating information related to a second advertisement and sending at least some of the aggregate information related to the second advertisement to the client terminal via a second channel of the communication network. The method also includes correlating the information related to the first advertisement with the information related to the second advertisement and swapping the first advertisement with the second advertisement if a subscriber has elected to receive substitute advertisement services and if there is a match in the correlated information, including replacing link information associated with the first advertisement with link information associated with the second advertisement.

### Summary of Hite et al.

The system of Hite et al. focuses on the preemption of commercials. In the system of Hite et al., sets of advertisements are prepared so that they are suitable for the transmission and storage. Each commercial is analyzed as to its nature and focus and a commercial identifier (CID) code is appended. The messages are then delivered to the point of usage.

Commercials can be classified into three categories: (1) non-preemptable; (2) conditionally preemptable; or (3) unconditionally preemptable. For example, commercials and programs not participating in the system and process would be non-preemptable. Some commercials and programs which are eligible for preemption may also be non-preemptable under some circumstances. These are called conditionally preemptable. An example of such a situation may be that a competitor's product may not be used to preempt. One brand of

automobile may be precluded from substituting for another brand of automobile. An unconditionally preemptable commercial may be subject to substitution at any time other higher priority commercials are available. In locations not equipped with hardware which implements the system and process, the preemptable commercials are displayed.

Commercials which are subject to preemption are embedded in programs along with a version of the CID to indicate under what circumstances a more suitable commercial may be substituted. A suitable process is used to target prospective viewers of a set of advertisements using database search and list selection procedures. The result of this process is a set of appropriate CID codes for the prospective viewers. These CID codes are transmitted to the viewing device and stored. At the point of usage, a commercial processor is programmed to find and analyze the CID codes in each commercial. When a match between the CID in the commercial and the CID transmitted and stored at the point of use is found, the advertisement is then presented to the viewer.

Summary of Bendinelli et al.

The system of Bendinelli et al. transmits uniform resource locators (URLs) or the network information identifiers with television signals in order to permit Web content to be displayed in synchronization with television programming. Illustratively, URLs are embedded in a closed captioned portion of a transmitted television signal and delimited from the close captioned text using predetermined delimiting characters. A decoder extracts the URL from the television signal and supplies the URL to a retrieval device which automatically retrieves corresponding Web pages or other similar information over a network. The retrieved Web pages are then displayed to a viewer in synchronization with related programming in the television signal. The retrieval device may be a set-top box associated with a television set that displays both a retrieved Web page and the corresponding television picture portion of the television

signal. Alternatively, the retrieval device may be a computer which retrieves and displays a Web page while the corresponding television picture is displayed on a television set.

#### Summary of Hinderks

The system of Hinderks focuses on broadcasting or multicasting digital data using an IP protocol to generate IP digital data, which is then transmitted from a multicast content source site to a remote Internet point-of-presence (POP) through a dedicated transmission channel substantially separate from the Internet backbone. Local commercials and/or other IP digital data may be inserted into the received IP digital data stream at the remote Internet POP. The IP digital data signal stream received at the POP may also be stored and/or delayed at the POP for a later playback and broadcasting/multicasting to recipients having a computer or other IP data receiving equipment connected to the Internet distal from the POP.

#### Summary of Alexander et al.

The system of Alexander et al. focuses on electronic programming guides by providing viewer interaction capabilities with the electronic programming guides; viewer control of video recording of future-scheduled programming; features to the electronic programming guides display and navigation; parental control of the electronic programming guide's display; television program information accessed by the viewer; opportunities for the commercial advertiser to reach the viewer; product information accessed by the viewer; creation of a viewer's profile; utilization of viewer profile information to customize various aspects of the electronic programming guide; and utilization of viewer profile information to customize presentation of advertising to the viewer.

#### The Claims Distinguished

The Office has failed to show, and applicant is unable to find, where any of the cited and applied references, either alone or in combination, disclose the subject matter of the claimed invention. For example, none of the applied and cited references teaches "swapping the first

advertisement with a second advertisement if a subscriber has elected to receive substitute advertisement services and if there is a match in the correlated information," as recited in Claims 1, 15, and 27. As another example, none of the applied and cited references teaches "the aggregator further capable of sending at least some of the aggregated information to cause a swap of the substitute advertisement in place of an original advertisement that is provided to the broadcast center if a subscriber has elected to receive substitute advertisement services," as recited in Claim 19. As a third example, none of the applied and cited references teaches "the aggregator further capable of sending at least some of the aggregated information to cause a swap of the second advertisement in place of the first advertisement if a subscriber has elected to receive substitute advertisement services," as recited in Claims 22 and 29. Applicant cannot find and the Office has failed to show where the cited and applied references teach or suggest "swapping the first advertisement with the second advertisement if a subscriber has elected to receive substitute advertisement services and if the correlated information determines that a swap is appropriate," as recited in Claim 32.

Given the defects of Hite et al., the Office has attempted to combine Hite et al. with a number of references, all of which combinations applicant specifically denies. For example, the Office has sought to combine Hite et al. with Bendinelli et al., but because Bendinelli et al. does not disclose a facility by which a subscriber can elect to receive substitute advertisement services, Bendinelli et al. cannot cure the defects of Hite et al. The Office has also sought to combine the defective combination of Hite et al. and Bendinelli et al. with Hinderks. Hinderks also fails to disclose a facility by which a subscriber can elect to receive substitute advertisement services, and it, too, cannot cure the defects of the defective combination of Hite et al. and Bendinelli et al. Finally, the Office has tried to combine Alexander et al. with the defective combination of Hite et al. and Bendinelli et al. Alexander et al. does not teach or suggest a facility by which a subscriber can elect to receive substitute advertisement services.

Subsequently, Alexander et al. cannot cure the defects of Hite et al. and Bendinelli et al., and there is no reason for their combination.

Because the Office has failed to state a *prima facie* case of obviousness, the rejections should be withdrawn. Independent Claims 1, 15, 19, 22, 27, 29, and 32 have been amended to clearly recite the subject matter of the claimed invention, and they are patentably distinguishable over the cited and applied references. Claims 2-14, 16-18, 20, 21, 23-26, 28, 30, 31, 33, and 34 are allowable because they depend from allowable independent claims and because of the additional limitations added by those claims. Consequently, reconsideration and allowance of Claims 1-34 is respectfully requested.

Respectfully submitted,

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#### CERTIFICATE OF MAILING

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Date: September 1, 2005

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